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Paper No. 10

In re Application of
Mark Rasper
Application No. 09/222,282
Filed: December 28, 1998
For: Knife Indexing Apparatus

: DECISION ON REQUEST
: FOR RECONSIDERATION

This is a decision on petitioner's request for reconsideration of the decision dated June 12, 2000 denying the original petition to withdraw the finality of the Office letter dated May 9, 2000. The request for reconsideration was timely filed on July 10, 2000.

The request for reconsideration is denied.

Familiarity with the original petition and the decision therein is presumed. In brief, in the first Office action, the examiner advanced a rejection for obvious under 35 USC 103 based upon two United States patents considered together, the Bailey patent and the Cavalli patent. In reply, petitioner argued petitioner was entitled to benefit of a provisional application and that the Bailey patent was therefore not available as a prior art reference in a 35 USC 103(a). In the next Office action, the examiner repeated exactly the same rejection as was advanced in the first Office action, and made the action final. The final action included the examiner's comments that the Bailey patent was indeed qualified as prior art under 35 USC 102(e) because it had an earlier filing date than the filing date of the provisional patent.

Petitioner continues to rehash the arguments presented in the original petition. Again, no rejection under 35 USC 102(e) was ever made. The examiner merely replied to an argument made by petitioner that the Bailey patent was not prior art. The examiner's reply explained why the Bailey patent was indeed qualified as prior art. That the examiner's reply relied upon the words 35 USC 102(e) and the words contained within that statutory provision did not convert the examiner's rejection under 35 USC 103(a) to anything other than precisely that, a rejection under 35 USC 103(a). The examiner was clearly within the practice set forth at MPEP 706.07(a) in making the second action final.

Petitioner may wish to consider the decision of the United States Court of Customs and Patent Appeals entitled *In re Wertheim and Mishkin*, 646 F.2d 527; 209 U.S.P.Q. 554, April 9, 1981; Amended April 15, 1981. The following language appears in the decision, beginning at 209 U.S.P.Q. 560:

"While nowhere in Title 35 are the words 'prior art' defined, the Senate and House Reports accompanying the 1952 [**15] Patent Act state:

> [Section 103] refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in Section 102. S.Rep. No. 1979, 82d Cong., 2d Sess., U.S. Code Cong. & Admin. News at 2399.

Additionally, one draftsman of and the commentator on the 1952 Act, P.J. Federico, commented that:

> The antecedent of the words "the prior art" * * * lies in the phrase "disclosed or described as set forth in Section 102" and hence these words refer to the material specified in Section 102 as the basis for comparison. Federico, Commentary On The New Patent Act, 35 USCA p. 1 at 20 (1954).

Commensurate with the Senate Report and Mr. Federico's commentary, we have held that the term 'prior art' refers 'to at least the statutory prior art material named in § 102.' In re Yale, 52 CCPA 1668, 347 F.2d 995, 146 USPQ 400 (1965). See In re Harry, 51 CCPA 1541, 333 F.2d 920, 142 USPQ 164 (1964).

In Hazltine, the court stated that earlier-filed applications for patents of another describing, although not necessarily claiming, the invention claimed in a later filed application, are prior art under § 102(e) and are available [**16] for consideration in support of a § 103 obviousness rejection of the later-filed application. See In re Bowers, 53 CCPA 1590, 359 F.2d 886, 149 USPQ 570 (1966). And, for purposes of both § 102 and § 103 analysis, they are prior art as of their filing dates. "

After considering the above, petitioner may wish to note that the *Wertheim* case involved a rejection *specifically phrased as being a rejection under §§ 102(e)/103*, for example at 209 U.S.P.Q. 557 wherein the Court stated:

> "After considering four motions by Pfluger, the Primary Examiner moved *sua sponte* to dissolve the interference and granted his own motion. In support of his decision, he stated that the claims copied by Wertheim were unpatentable under 35 USC 102(e) and/or 35 USC 103..."

and again at page 560 wherein the Court stated:

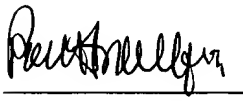
> "The §§ 102(e)/103 rejection, thus, is one utilized where § 102(e) alone may fail because not every material limitation of the claimed invention is disclosed in the reference. That reference, referred to as 'prior art' in § 103, may be combined with another to support an obviousness rejection. See In re Caveney, 55 CCPA 721, 386 F.2d 917, 155 USPQ 681 (1967)."

On the other hand, the petitioner should take note of the fact that in the present application, the examiner did not make a rejection under §§ 102(e)/103 in either the first action or the final action.

The examiner made only aSection 103(a) obviousness rejection in each action, and exactly the same rejection in each action. In answer to petitioner's traverse of the first action rejection, the examiner simply informed petitioner of the hornbook principle that the Bailey patent qualified as prior art notwithstanding petitioner's reliance on petitioner's provisional application, because the Bailey patent satisfied the language of 35 USC 102(e), which forms part of the "definition" of the term "prior art". In doing so, the examiner did not apply the Bailey patent in any Section 102 rejection, or make a premature final rejection.

The request for reconsideration has been granted to the extent that the Decision on Petition dated June 12, 2000 has been reconsidered in light of the request, but is denied with respect to granting any of the relief requested therein.

RECONSIDERATION DENIED.



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